

REMARKS

At the time of the Sixth Office Action dated May 26, 2009, claims 9-16 and 36-45 were pending and rejected in this application.

**CLAIMS 9-16 AND 36-45 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON DIACAKIS, U.S. PATENT PUBLICATION NO. 2003/0174814 (HEREINAFTER
DIACAKIS), IN VIEW OF ARAVAMUDAN ET AL., U.S. PATENT NO. 6,301,609 (HEREINAFTER
ARAVAMUDAN)**

On pages 3-6 of the Sixth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Diacakis and Aravamudan. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 4 of the Sixth Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Applicants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

(A) Determine the scope and content of the prior art;

- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Claim 9

Claim 9 recites that the method is performed within a telephone and that the telephone has a first connection to a packet switched network and a second connection to a circuit-switched telephone network. In the Amendment dated April 29, 2009 (hereinafter the Fifth Response), claim 9 was amended to clarify that the first connection is separate from the second connection. On page 2 of the Fifth Office Action, the Examiner: (i) cited Fig. 1 of Diacakis; (ii) identified IP Network 16 as corresponding to the claimed packet switched network; and (iii) identified PSTN 14 as corresponding to the claimed circuit-switched telephone network. Referring to Fig. 1 of Diacakis, the telephone only has a single connection (not the multiple, different connections, as claimed). In fact, the telephone 8 does not have a connection with the IP Network 16. Instead, the telephone 8 only has a connection with the telephone network 14. Thus, Diacakis fails to identically disclose the claimed limitations.

In response to the above-reproduced arguments, the Examiner asserted the following on page 4 of the Sixth Office Action:

Diacakis, however, does not disclose wherein the first connection is separate from the second connection. Aravamudan, however, does disclose wherein the first connection (See Fig. 1-2 and packet routing/switching module 122) is separate from the second connection (See Fig. 1-2 and PSTN switching module 124) (See col. 3 lines 26-44 and col. 9-10 lines 64-15).

After asserting that Aravamudan teaches the claimed "the first connection is separate from the second connection," the Examiner then presented the following obviousness analysis:

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate this limitation within the method, as a way of allowing communications and data to be bi-directionally exchanged between a client's device(s) (i.e., such as wireless cellular phone 150) and a service provider via a PSTN switching module and/or a packet routing/switching module.

Applicants respectfully submit that the Examiner's proposed rationale for the combination would not have led one having ordinary skill in the art to modify the applied prior art in the manner suggested by the Examiner. The Examiner's alleged benefit for the combination (i.e., "allowing communications and data to be bi-directionally exchanged between a client's device(s)") is discussed in column 3, lines 41-44 of Aravamudan, which is reproduced below:

The instant exemplary service provider 120 is shown providing both a Public Switched Telephone Network (PSTN) service and a packet-based service, such as an Internet access service, to the subscribing client's CPE 140. Communications and data are bi-directionally exchanged between the client's CPE 140 and the service provider via a PSTN switching module 124 **and/or** a packet routing/switching module 122. (emphasis added)

As discussed in the Examiner's cited passage, the alleged benefits are provided "via a PSTN switching module 124 **and/or** a packet routing/switching module 122" (emphasis added). Therefore, the proposed benefit could be provided by just a single one of the PSTN switch module 124 or the packet routing/switching module 122. Since the primary reference of

Diacakis already includes the PSTN 14 (comparable to the PSTN switch module 124 of Aravamudan) then the Examiner's proposed benefit would already be realized by the primary reference of Diacakis without the need for having a first connection separate from the second connection. Since the problem of "allowing communications and data to be bi-directionally exchanged" would have already been solved by Diacakis, one having ordinary skill in the art would not have been realistically impelled to make the Examiner's proposed modification.¹

Claim 10

Dependent claim 10 recites "selectively placing calls over the circuit-switched telephone network or over the packet-switched network." With regard to these limitations, on page 4 of the Sixth Office Action, the Examiner did not present any analysis. Instead, the Examiner only cited paragraphs [0022] and [0023] of Diacakis without comment. For ease of reference, paragraphs [0022] and [0023] of Diacakis are reproduced below:

FIG. 1 is a diagram of a system 10 according to one embodiment of the present invention. A caller may place a telephone communication, such as from the landline telephone 8 or the wireless telephone 9, to the voice gateway 12 by calling a certain directory number associated with the voice gateway 12. The outgoing communication from the caller is routed to the voice gateway 12 by a telephone network 14 such as, for example, a public switched telephone network. Calls from the wireless telephone device 9 may be routed to the PSTN 14 by a mobile switching center 18.

The voice gateway 12 is in communication with a server 20 via, for example, an IP network 16. The voice gateway 12 may bridge the PSTN 14 and the IP network 16 by converting and compressing voice into IP packets, and vice versa. According to one embodiment, the voice gateway 12 may be, for example, a voice XML gateway.

Applicants' review of these cited passages yields no mention of selectively placing a call over the circuit-switched telephone network or over the packet-switched network. These cited passages describe that "the voice gateway 12 may bridge the PSTN 14 and the IP network 16."

¹ See the non-precedential opinion of *Ex parte Rinkevich*, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

Assuming arguendo that the voice gateway 12 makes a selection of the IP network 16 (i.e., corresponding to the claimed packet-switched network), this step is performed within the voice gateway 12. However, as claimed, the step of "selectively placing a call" is performed within the telephone itself.

Therefore, Diacakis fails to teach the limitations for which the Examiner is relying upon Diacakis to teach, and the Examiner has not properly characterized the scope and content of the applied prior art, which is one of the required Graham factual inquiries

Claim 13

Dependent claim 13 recites "routing a call to the circuit-switched network or to the packet-switched network according to a user preference associated with the selected number." With regard to these limitations, on page 5 of the Sixth Office Action, the Examiner did not present any analysis. Instead, the Examiner only cited paragraphs [0028] and [0038] of Diacakis without comment. For ease of reference, paragraphs [0028] and [0038] of Diacakis are reproduced below:

It should be noted that an individual needs to be present on a network in order to be available, yet the opposite is not necessarily true. In addition, presence is absolute. That is, a person is either present or not on a given network. However, availability depends on, e.g., other people, situations, circumstances, personal preferences, etc. For example, an individual can be available to a first group of people, but unavailable to a separate group. That is, an individual may define a set of profiles that provide different subscribers (based on the subscriber's access level, such as important, restricted, normal, etc.) different contact information depending upon the individual's current situation (such as at home, at work, on the road, etc.). These profiles and associated contact information may be stored in an associated database 26 of the presence server 24. Based on the subscriber's access level and the individual's situation, the presence server 24 may retrieve the appropriate contact information of the individual for each subscriber of the individual's information from the database 26.

By way of example, assume the caller calls the voice gateway 12 to get George's contact information. Without use of the P&A information such as is the case for the method illustrated in FIG. 5, the voice gateway 12 (in conjunction with the server 20 and the presence server 24) may provide to the caller all of George's phone numbers listed in George's contact profile, such as work number, home number, wireless number, etc. For an embodiment that additionally uses the

detected P&A information for George, such as illustrated in FIG. 6, the voice gateway 12 (in conjunction with the presence server 24) may only provide the number for which George is currently present and available to the caller (given the caller's access level), which may be a subset of all the numbers associated with George in the contacts profile. Upon receiving this information, the voice gateway 12 may be further provisioned to allow the caller to initiate a communication to George, as described previously.

Although the Examiner's cited passages refers to profiles, entirely absent from the Examiner's cited passages is any mention that these profiles describe how a particular call is to be routed. In fact, the Examiner's cited passages are silent as to the routing the call to the circuit-switched network or to the packet-switched network, as claimed.

Therefore, Diacakis fails to teach the limitations for which the Examiner is relying upon Diacakis to teach, and the Examiner has not properly characterized the scope and content of the applied prior art, which is one of the required Graham factual inquiries

For the above-described reasons, the Examiner has failed to establish that the claimed invention, as recited in claims 9-16 and 36-45, would have been obvious within the meaning of 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 9-16 and 36-45, under 35 U.S.C. § 103 for obviousness based upon Diacakis and Aravamudan.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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